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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	:	Behler et al.
Appl. No.	:	09/463,675
Filed	:	05/12/00
Title	:	LOW VISCOSITY DISPERSION FOR PAPER OR TEXTILE PROCESSING
Grp./A.U.	:	1751
Examiner	:	J.R. Hardee
Docket No.	:	H 3033 PCT/US

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on February 25, 2002.

February 25, 2002
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

Commissioner for Patents
Washington, DC 20231

TRANSMITTAL OF REPLY BRIEF

Sir:

On January 31, 2002, an Examiner's Answer to Appellants' brief in support of the appeal against the final rejection of the pending claims in the above-captioned application was mailed. What follows in the remainder of this paper is Appellant's reply brief, as permitted by 37 C.F.R. § 1.193(b).

Appellant respectfully requests the Board of Patent Appeals and Interferences, before making its decision on this appeal, to consider the following rebuttals to statements made in the Examiner's Answer as set forth specifically below.

REPLY BRIEF

Statement: *"No viscosities or particle sizes are disclosed, but examples 4 and 5 are described as being "low-viscosity". Examiner takes the position that the person of ordinary skill in the surfactant art could reasonably infer the importance of minimizing viscosity based on this disclosure." (Part (10), page 4 of the Answer.*

Rebuttal: The Examiner clearly and unequivocally admits that examples 4 and 5 are described as being "low-viscosity" and makes reference to the importance of "low-viscosity" to those of ordinary skill in the art. However, as is clearly seen from said examples 4 and 5, neither one employs a nonionic surfactant and a polyol **in the claimed ratio by weight**. Thus, logic would dictate that those of ordinary skill in the art would have no reason to employ the claimed ratio by weight based on this reference clear **teaching away** therefrom, i.e., the ratio by weight disclosed in examples 4 and 5 is sufficient to achieve a low-viscosity emulsion.

Statement: *"The data in applicant's specification have been carefully considered, but they are not considered to demonstrate unexpected results commensurate in scope with the claims because data for the elected nonionic emulsifier are not presented." (Part (10), page 5 of the Answer)*

Rebuttal: It is clearly seen from the data contained in Appellant's specification that Example 1, which employs a ratio by weight of nonionic surfactant to polyol of approximately 2:1 results in the formation of an emulsion having a satisfactory viscosity, as opposed to Examples 2 and 3 which employ a ratio by weight of nonionic surfactant

to polyol **outside the claimed range** which result in the formation of an emulsion having a viscosity so unacceptably high that it cannot even be measured. The unexpected and superior results obtained through the use of the claimed ratio by weight are believed by Appellant to be **clearly and unequivocally** supported by the Examples.

Statement: *"The ratio recited by appellant is sufficiently broad that combining these ingredients in random amounts within the preferred ranges would afford a better than even chance of making a composition which meets appellant's ratio." (Part (11), page 6 of the Answer)*

Rebuttal: It is extremely well settled that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, *Ex parte Gerlach*, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). The Examiner's assertion that, based purely on statistics, one skilled in the art has a chance of combining a nonionic surfactant and polyol in the claimed ratio by weight is an insufficient basis for establishing prima facie obviousness. It is based on the belief in two faulty premises, namely, speculation/luck and the belief that one skilled in the art, after having read this reference, would even choose to vary the ratios by weight in which the components are used in order to arrive at the claimed ratio by weight.

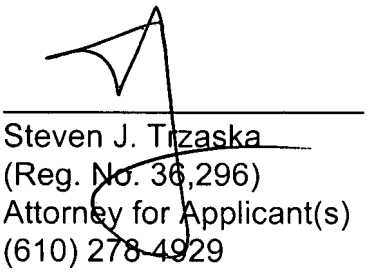
With respect to the first premise, it has been held that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis." See, *In re Warner*, 154 USPQ 173, 178 (CCPA 1967).

As for the second premise, as has already been admitted to by the Examiner, examples 4 and 5 of the Weinelt reference indicate that a low-viscosity emulsion can be

obtained without the need to employ Appellant's claimed components in the **claimed ratio by weight**. Thus, clearly exists no motivation on the part of the routineer to wish to unduly experiment with varying ratios by weight with the hopes of by chance stumbling across Appellant's claimed ratio by weight of components in order to prepare a low-viscosity emulsion since one can be obtained using the ratios by weight disclosed in examples 4 and 5 of the reference. It is extremely well settled that in order to establish a prima facie case of obviousness under 35 U.S.C. § 103 based upon a single reference, the Office must show an art-recognized motivation to modify the reference in the manner asserted by the Office. See, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). No such motivation is believed by Appellant to exist, based on the disclosure in Weinelt. Rather, just the opposite is believed to be the case in view of examples 4 and 5 disclosed therein.

In view of the arguments given above, and in the Appeal Brief, reversal of all the rejections is respectfully requested.

Respectfully submitted,



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